

Application No. 10/076,822  
Applicant: Dr. Thorsten Krawinkel  
Amendment in Response to Office Action dated May 30, 2003

#### REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 1-13 are pending. New claims 10-12 have been added in response to the rejections under 35 U.S.C. 112, second paragraph. Claim 13 is completely new. Amendments have been made to claims 1, 3-6, 8 and 9 in response to the rejections under 35 U.S.C. 112, second paragraph. Additional amendments have been made to claim 1 in response to the rejection under 35 U.S.C. 103 to show that the adhesive sheet strip does not discolor a substrate and/or article to which it is adhered. Support for the amendment is found in the specification at page 2, last paragraph, and starting at page 6, lines 17-28 until page 7, lines 1-2, and the examples found at pages 14 and 15. A mark-up showing the changes that have been made to these claims using strikethrough and underlining is attached. It is believed that no new matter has been added.

#### Oath or declaration

The Examiner found the oath or declaration defective. Submitted herewith is a copy wherein the signature and date of execution are clearly legible.

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Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 1-9 under 35 U.S.C. 112, second paragraph as being indefinite. In response, Applicant submits the claims are now amended to place them in better patent practice format. The phrase "for a bond" in claim 1 has been canceled. Claim 1 has been amended in part to show: "An adhesive sheet strip for bonding to a substrate and/or an article along a bond plane". The subject matter found in the "in particular" phrases of claims 3, 4, and 6 have been made the subject of dependent claims 10-12. The phrase "where appropriate" has been canceled in claims 5 and 9, and replaced by the normally acceptable "optionally." Claim 6 has been amended to show that one or both sides of the instantly claimed adhesive strip is provided with the pressure sensitive adhesive. Claim 8 has been amended for clarity to show the adhesive sheet strip comprising a pressure sensitive adhesive with a nonadhesive grip tab or the adhesive sheet strip being in the form of a laminate. Support is found at page 13, lines 10-11 of the specification.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

Claims 1-9 stand rejected under 35 U.S.C. 103(a) as being obvious over Applicant's statements in the specifications in view of Gergen et al. (U.S. Patent No. 4,578,429). The Examiner alleges the Applicant has admitted various elements of the claimed invention to be

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well-known, wherein the missing element is the presence of "any motivation to combine the two into forming a genus of stretch releasable adhesive tapes as applicant claims." The Examiner found Gergen to teach elastomeric block copolymers that can be modified with acid compound derivatives that result in a wide variety of desirable properties such as adhesion and appearance in the resultant articles and substrates. The Examiner found in view of the improved properties allegedly taught by Gergen that it would have been obvious to substitute the acid-modified or acid-anhydride-modified elastomers into the sheet or tape embodiments. The Examiner also found the parameters in claims 3 and 4 and the presence of additives and tackifiers in claim 5 to be obvious optimization parameters.

In response, Applicant points out that the Examiner appears to take the position in the last paragraph on page 3 of the Office Action that Applicant has admitted that the prior art includes "stretch release adhesive tapes that can have a pressure sensitive adhesive based on an elastomer that has been modified with acids and/or acid anhydrides." Applicant respectfully submits that he made no such admission, and, if the Examiner disagrees, Applicant respectfully requests that the Examiner point to page and line number where such admissions are seen.

Applicant also believes the motivation is missing, even though the Examiner believes otherwise. Gergen does not relate to stretch-release adhesive tapes, and it is not clear as to why someone would look to Gergen to modify stretch-release adhesive tapes. Gergen discusses at column 4, lines 25-30, modified block copolymers which "are excellent in appearance characteristics", but nowhere does the reference explain what is meant by

"appearance characteristics," or elaborate as to the relevance of its "appearance characteristics" on an article and/or substrate. The mere fact that references can be combined or modified, which Applicant does not concede here, does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The combination of cited references contains no suggestion to use Gergen's elastomers in the known stretch-release adhesives, and does not suggest any specific benefit to be gained by such use, and certainly not the advantages that Applicant has disclosed and proven in the instant specification.

As discussed in the instant specification at the bottom of page 6, the problem the present invention addresses is not discoloration in the adhesive itself, but discoloration of the substrate and/or article to which the adhesive is bonded. As noted above, Gergen at column 4, lines 25-30, teaches that "the modified block copolymers," i.e., the adhesive itself, are characterized by excellent appearance characteristics. Consequently, whereas whatever Gergen is talking about concerns the adhesive itself, the present invention solves a problem relating to the substrate and/or article to which the adhesive is adhered. It is unclear exactly what Gergen is talking about, but it is absolutely clear that Gergen is talking about something different than the problem the present invention solves.

Even if the Examiner is correct in his allegations that a person skilled in the art would have been motivated to combine the prior art teachings, this would have only established a *prima facie* case of obviousness, and an expectation that an appearance characteristic, which is,

again, not clearly explained by Gergen, would have been improved. The combination of the prior art references certainly do not suggest overcoming the problem of the discoloration to a substrate and/or article when an adhesive is bonded thereto, and this problem is a problem of great practical significance affecting the customer's desire to purchase the product in the first place.

Inasmuch as Gergen does not allude to this problem and the present formulation solves it, Applicant's solution thereto must be regarded as unexpected and therefore nonobvious. Applicant refers the Examiner to the data found in the examples at pages 14-15 in the specification, wherein examples 4 and 6-9 which are modified with an acid anhydride show a superior discoloration tendency. Visible discoloration in examples 4 and 6-9 appear only after at least 7 weeks, whereas comparative examples 1-3 and 5 show discoloration after bonding for only 3 weeks. Thus, the present invention provides a clear advantage in delaying the onset of discoloration for a significant period of time. There is absolutely nothing whatsoever in the combination of the known prior art and Gergen that would have suggested these results. Accordingly, these data must be regarded as surprising, and, therefore, unexpected, and, consequently, as objective evidence of nonobviousness. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

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Referring to the parameters in claims 3 and 4 and the presence of additives and tackifiers in claim 5, Applicant submits they will stand or fall based on the argument presented above for overcoming the rejection of claim 1.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

#### Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.